

08/858389



**UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/858,389 05/19/97 FOERSTER

S A-1028CON

EXAMINER

QM32/0723

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ART UNIT

PAPER NUMBER

3764

DATE MAILED:

07/23/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/858,389

Applicant(s)
Seth A. Foerster et al.

Examiner
Benjamin Koo

Group Art Unit
3764



☒ Responsive to communication(s) filed on Apr 29, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1, 4-6, 9-12, 14-17, 35-39, and 42-44 is/are pending in the application.

Of the above, claim(s) 4, 6, 9-12, 38, 39, and 42 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1, 5, 14-17, 35-37, 43, and 44 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Election/Restriction

1. Claims 4, 6, 9-12, 38, 39, and 42 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected species, the requirement having been traversed in Paper No. 11.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 5, 15-17, and 35-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Komiya '576 in view of Eggers '314. Komiya shows a device comprising: a discrete marker element (11), a deliver apparatus or tube lumen (10), a deployment actuator connector (19), a forming die (21), the marker element being able to travel along the tube, and a mandrel (20), but does not show the cutting tip or the vacuum. As is known in the art, devices such as Komiya are often used in combination with endoscopes which deliver the devices to the appropriate site. Eggers shows such an endoscope which can be used to deliver various devices to a surgical site, Eggers further show a cutting tip (12) and the use of a vacuum. It would have been obvious to

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one of ordinary skill at the time the invention was made to have used Komiya in conjunction with Eggers because both devices are known to be used with one another in the art. The cutting edge of Isse is obviously used to pierce the skin to get to a location and the vacuum can be use to extract debris often associated with this kind of procedure. It is further obvious and inherent for these devices to be used in combination with various types of visualization and guidance systems as known in the art, but even so, in the claims, absent any structure to define such additional elements, these limitations will not be given weight. Limitations drawn to various markers shapes or sizes are considered obvious choices of design based on user preference.

4. Claims 14, 44, and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Komiya, Eggers, and Kirsch et al.. Komiya and Eggers shows everything except the deployment actuator having a predetermined failure point. Kirsch et al. shows such a configuration. It would have been obvious to have used the deployment actuator mechanism of Kirsch et al. in Komiya as an obvious art-recognized alternative deployment means. Both devices are used to place invasive marker elements of a similar type for similar purposes. The substitution of one type of actuator for another would have been obvious to a skilled artisan.

5. Any inquiry concerning the specifics of this communication should be directed to Examiner Ben Koo who can be reached at 703-308-2657.

bk

July 19, 1999



Richard J. Apley
Supervisory Patent Examiner
Group 3700